



IFW  
AF/  
+

<b>TRANSMITTAL FORM</b> <i>(to be used for all correspondence during pendency of filed application)</i>	Application Number	09/898,497	
	Filing Date	July 5, 2001	
	First Named Inventor	Hirohisa A. Tanaka	
	Group Art Unit Number	3627	
	Examiner Name	James S. McClellan	
Total Number of Pages in This Submission	14	Attorney Docket Number	20662-07121

ENCLOSURES (check all that apply)	
<input checked="" type="checkbox"/> Fee Transmittal Form (in duplicate) <input type="checkbox"/> Check Enclosed	<input type="checkbox"/> Issue Fee Transmittal
<input checked="" type="checkbox"/> Return Receipt Postcard	<input type="checkbox"/> Letter to Chief Draftsperson
<input type="checkbox"/> Response to Notice to File Missing Parts	<input type="checkbox"/> Formal Drawing(s): [ ] Sheet(s) of Figure(s) [ ]
<input type="checkbox"/> Assignment & Recordation Cover Sheet	<input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences
<input type="checkbox"/> Declaration	<input checked="" type="checkbox"/> Appeal Communication to Group – Appeal Brief (Appeal Notice, Brief, Reply Brief)
<input type="checkbox"/> Power of Attorney	<input type="checkbox"/> Certified Copy of Priority Document(s)
<input type="checkbox"/> Application Data Sheet	<input type="checkbox"/> After Allowance Communication to Group
<input type="checkbox"/> Information Disclosure Statement & PTO/SB/08A <input type="checkbox"/> Copies of IDS Cited References	<input type="checkbox"/>
<input type="checkbox"/> Request for Corrected Filing Receipt	<input type="checkbox"/>
<input type="checkbox"/> Request for Correction of Recorded Assignment	<input type="checkbox"/>
<input type="checkbox"/> Amendment/Response: [ ] Page(s) <input type="checkbox"/> After Final	<input type="checkbox"/>
<input type="checkbox"/> Status Request	<input type="checkbox"/>
<input type="checkbox"/> Revocation and Substitute Power of Attorney	<input type="checkbox"/>
REMARKS:	

SIGNATURE OF ATTORNEY OR AGENT			
Signature:			
Attorney/Reg. No.:	Daniel R. Brownstone 46,581	Dated:	October 25, 2004

CERTIFICATE OF MAILING			
I hereby certify that this correspondence, including the enclosures identified above, is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Mail Stop Appeal Brief-Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below. If the Express Mail Mailing Number is filled in below, then this correspondence is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service pursuant to 37 CFR 1.10.			
Signature:			
Typed or Printed Name:	Daniel R. Brownstone	Dated:	October 25, 2004
Express Mail Mailing Number (optional):			



IN THE UNITED STATES

PATENT AND TRADEMARK OFFICE

APPLICANT(S): Hirohisa A. Tanaka  
APPLICATION NO.: 09/898,497  
FILING DATE: July 5, 2001  
TITLE: Method and Apparatus For Location-Sensitive, Subsidized Cell  
Phone Billing  
EXAMINER: James S. McClellan  
GROUP ART UNIT: 3627  
ATTY. DKT. NO.: 20662-07121

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Mail Stop Appeal Brief- Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the date shown below:

Dated: 25 OCT 2004

By:

Daniel R. Brownstone, Reg. No.: 46,581

MAIL STOP APPEAL BRIEF-PATENTS  
COMMISSIONER FOR PATENTS  
P.O. BOX 1450  
ALEXANDRIA, VA 22313-1450

APPEAL BRIEF

Real Party in Interest

The real party in interest in this Appeal is Telcontar, a California corporation.

Related Appeals and Interferences

No other prior or pending appeals, interferences or judicial proceedings are known to Appellant, Appellant's legal representative, or the Assignee that may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

11/01/2004 CCHAU1 00000003 192555 09898497

02 FC:2402 170.00 DA

### **Status of Claims**

Claims 1-33 are pending in this Application and stand rejected. Claims 1-33 are included in this Appeal.

### **Status of Amendments**

An Amendment after Final Rejection ("Amendment C") was filed on May 25, 2004. To the Applicant's knowledge, no action has been taken on the Amendment by the Examiner, and no Advisory Action has been received. Accordingly, for purposes of this Appeal, Applicant proceeds with the understanding that the Amendment was not entered.

During preparation of this Brief it was discovered that claim 33 contains a typographical error making the claim appear to depend from claim 23. In fact, the claim should depend from the claim immediately above it, claim 32.

### **Summary of Claimed Subject Matter**

The claimed invention enables telephone service providers and/or commercial establishments to provide an incentive to subscribers to place or receive mobile telephone calls or use mobile telecommunications data services from dynamically specified geographic locations by offering them a subsidy for calls made within a specified zone. (Spec., p. 3, lines 22-29.)

The independent claims of the application, claims 1, 12 and 23, refer, respectively, to a method, system and computer program product for determining a billing rate of a mobile telecommunications connection associated with a mobile telecommunications unit (MU). (Spec. p. 3, line 22-p. 4, line 18.) In particular, the billing rate is dependent upon whether the MU is inside or outside of a predetermined subsidized zone. (Spec. p. 7, lines 6-9; p. 9, lines 20-26.) If the MU is determined to be inside a subsidized zone, the connection is billed at a first

predetermined rate. If, on the other hand, the MU is determined not to be inside the subsidized zone, the connection is billed at a second predetermined rate. (Spec. p. 3, lines 24-29).

### **Grounds of Rejection to be Reviewed on Appeal**

Claims 1, 2, 4, 6-13, 15, 17-24, 26, 28-33 are rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Application No. US 2002/0077130 A1 to Owensby ("Owensby").

Claims 3, 5, 14, 16, 25 and 27 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Owensby in view of U.S. Patent No. 6,411,891 to Jones ("Jones").

### **Argument**

#### **Rejections Under 35 U.S.C. § 102(e)**

##### **Claims 1, 2, 4, 6-13, 15, 17-24, 26, 28-33**

The Examiner rejected claims 1, 2, 4, 6-13, 15, 17-24, 26, and 28-33 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Application No. US 2002/0077130 A1 to Owensby. To anticipate a claim under § 102(e), a prior art reference must describe each and every element as set forth in the claim, either expressly or inherently. *Trintec Indus., Inc. v. Top-U.S.A. Corp.*, 295 F.3d 1292, 1295 (Fed. Cir. 2002); *In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999); *Verdegad Bros., Inc. v. Union Oil Co.*, 814 F.2d 628, 631 (Fed. Cir. 1987); *see also* MPEP § 2131. The rejection was improper because Owensby does not describe all of the limitations of the rejected claims.

Owensby discloses providing a subsidy to mobile phone users who agree to receive advertisements on their wireless devices. (Owensby paragraph 60.) If the user does not accept advertisements, then there is no subsidy applied. (Owensby para. 62.) If a user does accept advertisements, then the advertisements delivered to the wireless device are selected by an Ad

Selection Code Generator according to demographic and personal preference information obtained from the subscriber, including the location of the subscriber at the time of the call, and additionally according to which advertisements were previously provided to the user. (Owensby para. 63.)

In contrast, the claimed invention recites adjusting the billing rate “responsive to a determination that the location of the MU is inside the predetermined subsidized zone.” Unlike Owensby, which requires the user to accept an advertisement in order to get a discount, the claimed invention changes the billing rate for the user subject only to the location of the MU. This is a feature not taught, disclosed or suggested by Owensby. For example, according to the disclosure of Owensby, two wireless device users, User A and User B, could each make a call from the same location to the same telephone number, and yet User A, who receives advertisements, pays a lower rate for the call than does User B, who declines to receive ads. In contrast, in the claimed invention, since User A and User B are at the same location, they are either both “inside the subsidized zone” or “outside the subsidized zone”—and both User A and User B either receive or do not receive the subsidy, since the claimed invention recites an adjusted billing rate responsive to a determination that the location of the MU is inside the predetermined subsidized zone, and does not require additional affirmative steps be taken by the user, such as the acceptance of an advertisement.

Because Owensby teaches offering a subsidy in exchange for accepting advertisements, and not responsive to a user’s location, Owensby clearly does not describe each and every element as set forth in the claimed invention, either expressly or inherently, as is required to support a rejection under 35 U.S.C. § 102(e). Accordingly, claims 1-2, 4, 6-13, 15, 17-24, 26 and 28-33 are patentable over Owensby, and the rejection of those claims should be reversed.

## Rejections Under 35 U.S.C. § 103(a)

### Claims 3, 5, 14, 16, 25 and 27

The Examiner rejected claims 3, 5, 14, 16, 25 and 27 under 35 U.S.C. § 103(a) as being unpatentable over Owensby in view of Jones.

Jones discloses a system for notifying users of the impending arrival of a transportation vehicle at a particular vehicle stop. The Examiner cites a portion of Jones that discloses tracking a vehicle using its longitude and latitude readings or a Universal Transverse Mercator (UTM) grid system (Jones col. 17, lines 8-10). At the outset, the two references are not from an analogous art, and indeed are not properly combinable. References qualify as prior art for an obviousness determination only when analogous to the claimed invention. *In re Bigio*, 381 F.3d 1320 (Fed. Cir. 2004); *In re Clay*, 966 F.2d 656, 658 (Fed. Cir. 1992); *see also* MPEP § 2141.01(a). Jones, directed to predicting the arrival of a vehicle such as a school bus at a bus stop, is analogous neither to Owensby, which discloses subsidizing wireless device users for receiving advertisements, or to the claimed invention, which subsidizes users for using a device inside a subsidized zone. Accordingly, it is improper to combine Jones with Owensby.

Even if Jones and Owensby could be properly combined, the combination still does not teach the claimed invention. As discussed above with respect to the rejections under 35 U.S.C. § 102(e), Owensby fails to disclose adjusting a billing rate “responsive to a determination that the location of the MU is inside the subsidized zone”. Jones does nothing to cure this defect. Accordingly, even the combination of Jones and Owensby does not disclose each of the limitations of claims 3, 5, 14, 16, 25 or 27, and those claims are therefore patentable over the combination of references.

### Summary

Owensby's disclosure is substantially different from the claimed invention. Owensby does not suggest or disclose providing a billing rate dependent upon the location of a mobile telecommunications unit. Instead, Owensby provides a subsidy to subscribers that agree to receive advertisements in exchange for the subsidy. The two approaches are patentably distinct—Owensby differentiates among subscribers, offering some a subsidy and some not, depending on their willingness to accept an advertisement. The location of the user in Owensby is unrelated to whether or not he receives the subsidy—it is relevant only to determine which advertisement he receives, should he choose to accept one. In contrast, in the claimed invention, it is the location of the user that determines whether a billing rate adjustment is applied, and no advertisement or other action by the user need be undertaken.

Accordingly, the Examiner's rejections of claims 1-33 were erroneous, and Applicant respectfully requests that the Board reverse.

Respectfully submitted,  
**HIROHISA A. TANAKA**

Dated: 25 OCT 2004

By: 

Daniel R. Brownstone Reg. No.: 46,581  
Fenwick & West LLP  
Silicon Valley Center  
801 California Street  
Mountain View, CA 94041  
Tel.: (415) 875-2358  
Fax.: (650) 938-5200

### Claims Appendix

1. A method for determining a billing rate of a mobile telecommunications connections associated with a mobile telecommunications unit (MU), comprising the steps of:

determining whether a location of the MU is inside or outside a predetermined subsidized zone;

responsive to a determination that the location of the MU is inside the subsidized zone, adjusting the billing rate for the telecommunications connection to a first predetermined billing rate; and

responsive to a determination that the MU is outside the predetermined subsidized zone, adjusting the billing rate for the telecommunications connection to a second predetermined billing rate.

2. The method of claim 1, wherein the first predetermined billing rate is less than the second predetermined billing rate.

3. The method of claim 1, wherein the location is defined by latitude and longitude.

4. The method of claim 1, wherein the location is determined by a Global Positioning System (GPS).

5. The method of claim 1, wherein the location is defined by Universal Transverse Mercator (UTM) numbers.

6. The method of claim 1, wherein information corresponding to the predetermined subsidized zone is stored in a database.

7. The method of claim 6, wherein the predetermined subsidized zone information comprises a time period, and wherein the billing rate is reduced when the telecommunications connection occurred at least in part during the time period.



8. The method of claim 1, wherein the predetermined subsidized zone is defined by a geographical point and a radius.

9. The method of claim 2, wherein the predetermined subsidized zone is associated with a proximity to a commercial establishment and the commercial establishment pays the first predetermined billing rate.

10. The method of claim 1, wherein the predetermined subsidized zone is one of a plurality of predetermined subsidized zones, each associated with a proximity to a different commercial establishment.

11. The method of claim 10, wherein the ~~standard~~ billing rate is reduced by a first amount when the location of the MU is within a first predetermined subsidized zone, and the billing rate is reduced by a second amount when the location of the MU is within a second predetermined subsidized zone.

12. A system for determining a billing rate of a mobile telecommunications connection associated with a mobile telecommunications unit (MU), comprising:

- a processor;

- memory for storing computer readable instructions that, when executed by the processor, cause the system to perform the operations of:

- determining whether a location of the MU is inside or outside a predetermined subsidized zone;

- responsive to a determination that the location of the MU is inside the predetermined subsidized zone, adjusting the billing rate for the telecommunications connection to a first predetermined billing rate;
  - and

- responsive to a determination that the MU is outside the predetermined subsidized zone, adjusting the billing rate for the telecommunications connection to a second predetermined billing rate.

13. The system of claim 12, wherein the first predetermined billing rate is less than the second predetermined billing rate.

14. The system of claim 12, wherein the location is defined by latitude and longitude.

15. The system of claim 12, wherein the location is determined by a Global Positioning System (GPS).

16. The system of claim 12, wherein the location is defined by Universal Transverse Mercator (UTM) numbers.

17. The system of claim 12, wherein information corresponding to the predetermined subsidized zone is stored in a database.

18. The system of claim 17, wherein the predetermined subsidized zone information comprises a time period, and wherein the billing rate is reduced when the telecommunications connection occurred at least in part during the time period.

19. The system of claim 12, wherein the predetermined subsidized zone is defined by a geographical point and a radius.

20. The system of claim 12, wherein the predetermined subsidized zone is associated with a proximity to a commercial establishment and the commercial establishment pays the first predetermined billing rate.

21. The system of claim 12, wherein the predetermined subsidized zone is one of a plurality of predetermined subsidized zones, each associated with a proximity to a different commercial establishment.

22. The system of claim 21, wherein the billing rate is reduced by a first amount when the location of the MU is within a first predetermined subsidized zone, and the billing rate is reduced

by a second amount when the location of the MU is within a second predetermined subsidized zone.

23. A computer program product for determining a billing rate of a mobile telecommunications connection associated with a mobile telecommunications unit (MU) comprising a computer-readable medium containing computer program code for performing the operations of:

determining whether a location of the MU is inside or outside a predetermined subsidized zone;

responsive to a determination that the location of the MU is inside the predetermined subsidized zone, adjusting the billing rate for the telecommunications connection to a first predetermined billing rate; and

responsive to a determination that the MU is outside the predetermined subsidized zone, adjusting the billing rate for the telecommunications connection to a second predetermined billing rate.

24. The computer program product of claim 23, wherein the first predetermined billing rate is less than the second predetermined billing rate.

25. The computer program product of claim 23, wherein the location is defined by latitude and longitude.

26. The computer program product of claim 23, wherein the location is determined by a Global Positioning System (GPS).

27. The computer program product of claim 23, wherein the location is defined by Universal Transverse Mercator (UTM) numbers.

28. The computer program product of claim 23, wherein information corresponding to the predetermined subsidized zone is stored in a database.

29. The computer program product of claim 28, wherein the predetermined subsidized zone information comprises a time period, wherein the billing rate is reduced when the telecommunications connection occurred at least in part during the time period.

30. The computer program product of claim 23, wherein the predetermined subsidized zone is defined by a geographical point and a radius.

31. The system of claim 23, wherein the predetermined subsidized zone is associated with a proximity to a commercial establishment and the commercial establishment pays the first predetermined billing rate.

32. The computer program product of claim 23, wherein the predetermined subsidized zone is one of a plurality of predetermined subsidized zones, each associated with a proximity to a different commercial establishment.

33. The computer program product of claim 23, wherein the billing rate is reduced by a first amount when the location of the MU is within a first predetermined subsidized zone, and the billing rate is reduced by a second amount when the location of the MU is within a second predetermined subsidized zone.